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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO..
10/758,429	01/16/2004	Merrill Brooks Smith	64243.000006	5641
27682	7590	03/13/2006	EXAMINER	
HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT RIVERFRONT PLAZA, EAST TOWER 951 EAST BYRD ST. RICHMOND, VA 23219-4074			ST CYR, DANIEL	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/758,429

Applicant(s)

SMITH ET AL.

Examiner

Daniel St.Cyr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 and 61-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-59 and 61-71 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged that this application is a continuation application having an effective date of 9/24/01.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-7, 9-60 and 62-71 are rejected under 35 U.S.C. 102(e) as being anticipated by Gould et al, US pub. 2001/001856.

Gould et al disclose a prepaid cash equivalent card and system comprising: a cash equivalent server 10 comprises information processing means, a storage device 14 and a connection device 12, the connection device 12 allows the purchase authorization devices 31, such as a card reader 24, to connect to the cash equivalent server 10 to perform the interactive processes of card activation, authorization, financial transaction processing, and marketing information collection; the server 10 interprets and processes the requests received via the connection device 12, the storage device 14 stores data related to the processes performed and preferably comprises a database to hold information about cards and the executed transactions, the database stores merchant information for tracking card usage and activation locations, the cash equivalent server 10 is linked to financial institutions to manage the value associated with a card account, the cash equivalent card 40 is provided directly to a card selling and activating

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merchant 104 (or via a distributor that does not activate the card but merely resells it), the card is assigned a value at the point of purchase, by contacting the cash equivalent server 10 and setting the account balance corresponding to the card at the value specified (see figure 1; paragraph 27+). The structure of Gould et al is capable of performing all the method steps as set forth in the claims.

Allowable Subject Matter

4. Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. The following is a statement of reasons for the indication of allowable subject matter: Although the prior art of record teaches a system and method for conducting PIN-enable store value account refund, wherein the system verifies the account balance before authorized a refund, the system includes a cash equivalent server having information processing device, a storage device, and a connection device, the connection device allows purchase authorization devices, such as a card reader, to connect to the cash equivalent server to perform the interactive processes of card activation, authorization, financial transaction processing, refunds, etc., the prior art of record fails to disclose or fairly suggests providing a positive authorization when no value associated with store value account has been redeemed, a negative value when at least a portion of the associated value has been redeemed. These limitations in conjunction with other limitations in the claims were not shown by, would not have been obvious over, nor would have been fairly suggested by the prior art.

Response to Arguments

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6. Applicant's arguments filed 12/20/05 have been fully considered but they are not persuasive. (see examiner remarks).

REMARKS:

In view of the applicant's first argument that Gould does not disclose a system/method of refunding a value from a card account, the examiner respectfully disagrees. Gould discloses, in the preferred embodiment, refunds of the residual value **may not** be permitted (page , 0044, line 7). This indicates that refunds are permitted, even residual values in some instance are permitted. The applicant further argued that the anticipation is only based on that the structure of Gould being capable of performing the method steps of the claims. The structure is capable and inherently performed the method steps. For instance, if refunds are permitted by Gould, the method step of verifying the account balance (i.e. determining if any value has been redeemed) is inherently performed and that the system is capable of performing the verifying step. The applicant's argument seems to only base on the fact that the structure of Gould is capable performing the method steps of the claims. As explained above, Gould is capable or inherently performed the method steps of the claims.

In response to the applicant's second argument that the Gould does not disclose a refund system, only a refund fee, the examiner respectfully disagrees. Gould teaches that in the preferred embodiment that residual values **may not** be permitted, this indicates other type of refunds are permitted and that residual values are permitted may also be permitted.

In response to the applicant's third argument, that the refund that Gould mentions may have to do with returned merchandizes, the examiner respectfully disagrees. Gould teaches

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values left on the card, such residual values, after partially redeeming values store in the card.

Residual values do not consider and cannot be considered values from returned purchased items.

The applicant arguments are not persuasive. Refer to the rejection above.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel St.Cyr whose telephone number is 571-272-2407. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel St.Cyr
Primary Examiner
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A handwritten signature in black ink, appearing to read 'Daniel St. Cyr', is written over a large, stylized circular mark. The signature is fluid and cursive, with a long horizontal stroke extending to the right.

DS
March 6, 2006